



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/576,896	05/23/2000	Jason B. Thomas	1766.0020000	4511

7590 03/13/2003

Supervisor, Patent Prosecution Services
PIPER RUDNICK LLP
1200 Nineteenth Street NW
Washington, DC 20036-2412

EXAMINER

DUONG, OANH L

ART UNIT PAPER NUMBER

2155

DATE MAILED: 03/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/576,896

Applicant(s)

THOMAS ET AL.

Examiner

Oanh L. Duong

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 2155

Claims 1-19 are presented for examination.

Information Disclosure Statement

The related cases have been considered. However, no Form Pto-1449 has been found as it should be attached along with copies of the document.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 9-13 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6-10 of copending Application No. 09/576,896. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding 9, claim 6 of the above copending application recites all limitation in claim 9.

Regarding 10, claim 7 of the above copending application recites all limitation in claim 10.

Art Unit: 2155

Regarding 11, claim 8 of the above copending application recites all limitation in claim 11.

Regarding 12, claim 9 of the above copending application recites all limitation in claim 12.

Regarding 13, claim 10 of the above copending application recites all limitation in claim 13.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-11 and 14-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subbaroyan et al (Subbaroyan) (US 6,442,606) in view of Davies et al (Davies) (US 5,931,907).

Regarding claims 1 and 14, Subbaroyan discloses a method comprising collecting pages that are commonly transmitted over a computer network (see cols. 1-2 lines 44-11); collecting external data (see col. 1 lines 62-64); receiving a list of predetermined, entity-specific criteria (see col. 1 lines 44-48); receiving a list of rules, wherein a rule is composed of at least one of said criteria (see col. 7 lines 1-8); determining whether each of said pages satisfies each of said list of rules therefore obtaining a subset of said pages (see col. 7 lines 9-36); and obtaining additional

Art Unit: 2155

information on any of subset (see col. 1 lines 32-36). Subbaroyan does not teach generating a report as claimed. However, Davies teach generating a report wherein said report includes said list of predetermined, entity-specific criteria whereby said report is utilized to aid an entity in doing business over said computer network (see col. 2 lines 25-31 and col. 12 lines 53-54). Therefore, it would have been obvious to have used the generating a report in subbaroyan as taught by Davies because such generating report step would allow the user to access information by a much richer set of meta-information.

Regarding claims 2-4 and 15, Subbaroyan discloses global internet or intranet or extranet (see fig. 2 col. 6 lines 13-27).

Regarding claims 5 and 16, Subbaroyan does not teach grouping subset of pages and additional information to form a report; and obtaining contact information for said report. However, Davies teaches grouping subset of pages and additional information to form a report (see col. 2 lines 25-31 and col. 12 lines 53-54); and obtaining contact information for said report (see col. 7 lines 51-60). Therefore, it would have been obvious to have used the forming a report in subbaroyan as taught by Davies because such forming report step would allow the user to access information by a much richer set of meta-information.

Regarding claims 6 and 17, Subbaroyan does not teach group subset of pages and additional information to form a report; obtaining a score for each document of the subset of pages; and generating the report listing the scores of each of subset of pages. However, Davies teaches group subset of pages and additional information to form a

Art Unit: 2155

report (see col. 2 lines 25-31 and col. 12 lines 53-54; obtaining a score for each document of the subset of pages (see cols. 5-6 lines 61-7); and generating the report listing the scores of each of subset of pages (see col. 5 lines 44-60). Therefore, it would have been obvious to have used the report in subbaroyan as taught by Davies because such report would allow the user to access information by a much richer set of meta-information.

Regarding claims 7, 8, 18 and 19, Subbaroyan does not teach parsing the content of said page in said subset with predetermined categories; compiling statistics from said pages; storing said statistics; and analyzing said statistics by combining said statistics, said pages and said additional information. However, Davies teaches parsing the content of said page in said subset with predetermined categories (see cols 4-5 lines 62-13); compiling statistics from said pages (see col.5 lines 14-24); storing said statistics (see col. 5 lines 25-29); and analyzing said statistics by combining said statistics, said pages and said additional information (see cols. 8-9 lines 5-41). Therefore, it would have been obvious to have used the statistics in subbaroyan as taught by Davies because such statistics would allow the user to access information by a much richer set of meta-information.

2. Claims 9-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subbaroyan et al (Subbaroyan) (US 6,442,606) in view of Light (US 6,480,835).

Regarding claim 9, Subbaroyan discloses a system comprising a downloader for searching a computer network, wherein said computer network contains pages (see

Art Unit: 2155

cols. 1-2 lines 57-11); a page processing module for receiving said pages downloaded from said search of said computer network (see cols. 1-2 lines 57-11), said page processing module forming a list of pages (see col. 12 lines 40-57). Subbaroyan does not specifically teach an archive and a database as claimed. However, Light teaches an archive (document database 318) for storing said pages from each of said list, said pages being downloaded to said archive by said page processing module (see col. 12 lines 1-3 and col. 21 lines 44-56); and a database (search index 320) for allowing said page processing module to perform queries of said pages from said each of said list of pages, stored on said archive (see col. 12 lines 1-3), in order to produce a report (see col. 12 lines 8-12) whereby said report is utilized to aid an entity in doing business over said computer network (see cols. 2-3 lines 66-8). Therefore, it would have been obvious to have used the archive and database in Subbaroyan as taught by Light because such archive and database would enable the system to create and utilize integrated metadata, in which different types of search information about a set of documents is combined to allow efficient yet powerful searching of the set of documents.

Regarding claims 10-12, Subbaroyan discloses global internet or intranet or extranet (see fig. 2 col. 6 lines 13-27).

Regarding claim 13, Subbaroyan discloses plurality of Web clients that provides a graphic user interface for a user to enter search criteria and communicate with said downloader, thereby controlling said page processing module (see col. 2 lines 12-44).

Conclusion

Art Unit: 2155

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oanh L. Duong whose telephone number is (703) 305-0295. The examiner can normally be reached on Monday- Friday, 8:00AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz sheikh can be reached on (703) 305-9648. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



O.D
March 5, 2003



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100